

REMARKS

In the outstanding Official Action, claims 1-10 were rejected under 35 USC §103(a) as being unpatentable over the Dallas Semiconductor Product Review in view of Palowski. It was admitted in the Action that the Product Review does not disclose a control register that is instruction-settable to respective control states that control whether or not the processing device updates the at least two addresses as a side effect of executing the memory access instruction. However, it was suggested that Palowski overcomes this deficiency, and that since Palowski is in the related art of addressing memory in the 8051 series microcontroller it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Palowski into the Dallas Semiconductor Device.

On the contrary, Applicant respectfully submits that such a combination would not have been obvious or apparent to one of ordinary skill in the art at the time of the present invention absent the benefit of impermissible hindsight. More particularly, it is noted that both of the cited references are complex, lengthy documents, with the Dallas Semiconductor document running to 47 pages of complex, detailed technical information, and the Palowski patent containing 11 pages of drawing and 24 columns of text. Absent the benefit of impermissible hindsight derived from the instant disclosure, it would not be apparent to one of ordinary skill in the art to apply one particular narrow feature of Palowski

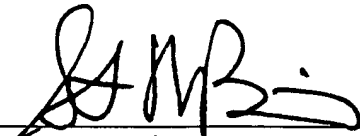
to the Dallas Semiconductor Device, and furthermore it is noted that absent the benefit of hindsight undue experimentation would be required to locate and apply a particular feature to obtain a particular advantage as disclosed and claimed by Applicant. Additionally, it is well settled that such a combination of references may not be made unless there is some motivation or teaching for this combination in the prior art, and in the present case there does not appear to be any such motivation or teaching.

Additionally, and again assuming that Palowski discloses the essential teachings absent from the Dallas Semiconductor Product Review, it is noted that the Palowski reference antedates the Product Review by several years, but yet it did not occur to the engineers at Dallas Semiconductor (or presumably at any other company) to actually make the combination as suggested in the Action, thus further establishing that the suggested combination is based upon impermissible hindsight.

Finally, it is respectfully submitted that even if the cited and applied references are deemed to be properly combinable, the currently-pending claims are clearly not rendered obvious by such a combination. The basis for this position has been extensively presented in the prior prosecution, and those arguments are hereby incorporated by reference in their entirety in the interest of brevity.

In view of the foregoing, it is respectfully submitted that the currently-pending claims are clearly patentably distinguishable over the cited and applied art. Accordingly, allowance of the currently-pending claims is now respectfully submitted to be justified, and favorable consideration is earnestly solicited.

Respectfully submitted,

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On 10/4/04

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